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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/801,182	03/06/2001	John Philipson	35682-8002US	4103
25096	7590	07/26/2005	EXAMINER	
PERKINS COIE LLP PATENT-SEA P.O. BOX 1247 SEATTLE, WA 98111-1247			TOOMER, CEPHIA D	
		ART UNIT	PAPER NUMBER	
		1714		

DATE MAILED: 07/26/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/801,182	PHILIPSON, JOHN	
	Examiner	Art Unit	
	Cephia D. Toomer	1714	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 13 April 2005.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1,3-6,9-23,27-29,33-41 and 44-50 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1,3-6,9-23,27-29,33-41,44-50 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

This Office action is in response to the amendment filed April 13, 2005 in which claims 1, 18 and 50 were amended and claim 42 was canceled.

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 1, 18 and their dependents are rejected under 35 U.S.C. 112, first paragraph, for the reasons of record as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

3. Applicant argues that there is support for the phrase "substantially free of glass, metals, plastics and paper." Applicant relies upon page 8, lines 26-32 to support this argument.

The examiner respectfully disagrees. The specification states that the solid waste is free or essentially free of hazardous waste. Glass, metals, plastics and paper are not considered hazardous waste. In addition the municipal solid waste should be free of or have a low content of recyclable materials. The term "low" as it refers to the amount of the recyclable material present in the solid waste does not particular point out how much of the solid waste material is recyclable materials. Is low 1%, 5%, 10%?

The claimed language "substantially free of" and "have a low content" are not synonymous.

4. The rejection of claim 18 under 35 U.S.C. 112, first paragraph is maintained.

The specification does not support adding at least one waste substance before and after step (b).

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claim 18 and dependents are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

It is not clear how the waste is treated in order to obtain a fluff. Clarification and correction are required.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 1, 3-6, 9-17, 44 and 45 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sprules (US 6,113,662).

Sprules teaches a fuel pellet comprising at least 50% spent dried coffee grounds (municipal solid waste), a combustible wax (hydrocarbon material), a coking agent

and/or a cellulose material (wood, leaves, etc) (see abstract; col. 2, lines 50-52, 64-66; col. 3, lines 37-44; col. 10, lines 39-59).

Sprules teaches that coffee grounds are clean burning and are less likely to produce polycyclic aromatic hydrocarbons during combustion (see col. 3, lines 24-36). Sprules teaches that the use of coffee grounds as a fuel source diverts waste from landfills (see col. 3, lines 61-63).

Table 1 shows that the coffee grounds have a heat value of 10,218 BTU/lb, moisture of 2.09 and ash content of 0.84wt%. Table 4 shows that the wax has a heating value of 18,000 BTU and wood has a heating value of 8,000 BTU. Sprules teaches the limitations of the claims other than the differences that are discussed below.

In the first aspect, Sprules differs from the claims in that he does not specifically teach the heating value of the fuel pellet. However, it would have been obvious to one of ordinary skill in the art to produce a fuel pellet possessing a fuel value of 10,000-14,000 BTU (claims 1 and 11-13) because Sprules teaches that the coffee grounds have a fuel value of 10,000 BTU, the wax has a heating value of 18,000 BTU and wood has a heating value of 8,000. Given these values and Sprules teaching that the fuel pellet contains at least 50% and up to 75% of the coffee ground, it would have been obvious to one of ordinary skill in the art to optimize these result effective variables to obtain fuel pellets that produce a hotter, cleaner burning fuel that releases fewer harmful pollutants and provides a brighter flame over a longer period of time (see abstract; Tables 1-4).

In the second aspect, Sprules differs from the claims in that he does not specifically teach that the solid waste is in the form of a fluff (claims 1 and 18). However, no unobviousness is seen in this difference because regardless of the form of the solid waste a fuel pellet will form. Applicant's choice of fluff as the form of the solid waste is merely a design choice. It is well settled that changes in size/proportions and shape is *prima facie* obvious if the claimed products do not perform differently from the prior art. In the instant case, the fuel pellets of the present invention perform the same function as the fuel pellets of Sprules. See MPEP 2144.04 IV(A and B).

In the third aspect, Sprules differs from the claims in that he does not teach the emissions properties of claim 9. However, given that Sprules teaches fuel pellets that contain no hazard waste, it would be reasonable to expect that the fuel pellets emissions would possess similar properties, absent evidence to the contrary.

In the fourth aspect, Sprules differs from the claims in that he does not specifically teach the size and shape of the fuel pellets. However, it is well settled that changes in size/proportions and shape is *prima facie* obvious if the claimed products do not perform differently from the prior art. In the instant case, the fuel pellets of the present invention perform the same function as the fuel pellets of Sprules. See MPEP 2144.04 IV(A and B).

9. Applicant's arguments have been fully considered but they are not persuasive.

Applicant argues that Sprules does not teach or suggest a combustible pellet having a fuel value of at least 10,000 BTU/lb wherein the pellet comprises recyclable-free hazardous waste-free municipal solid waste in the form of fluff and at least one

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waste substance having a fuel value of at least 10,000 BTU/lb. Applicant argues that the only municipal solid waste substance taught in Sprules is spent coffee grounds, which is not taught or suggested to be in the form of a fluff.

10. The examiner respectfully disagrees. Sprules teaches that the pellets of his invention may contain up to 75% coffee grounds and 25% wax (Example 1). Sprules teaches that the coffee grounds have an energy content (fuel value) of 10, 218 BTU/lb and wax has a energy content of 18,000 BTU/lb. Clearly this teaching suggests that a pellet prepared from these components would posses a fuel value of at least 10,000 BTU/lb. While the coffee grounds are not referred to as being in the form of a fluff, no criticality has been shown in what form the municipal waste takes.

11. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cephia D. Toomer whose telephone number is 571-272-1126. The examiner can normally be reached on Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on 571-272-1119. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Cephia D. Toomer
Primary Examiner
Art Unit 1714

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